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OFFICE OF PETITIONS

In re Application of :
Lin et al. :
Application No. 10/051497 : ON APPLICATION
Filing or 371(c) Date: 01/18/2002 : FOR
Attorney Docket Number: A0871.70000US01 : PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b), filed June 29, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is at least 87 days, not 0 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction based upon the assertion that (1) the Office erred in assessing reductions associated with the filing of two Information Disclosure Statements; (2) this Office failed to assess a reduction in connection with the filing of an Amendment under 37 CFR 1.312, and (3) the Office will take in excess of three years to issue this patent.

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

Because the correction of the adjustment will not result in a change in Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance remains zero (0) days (adjustments totaling 344 days less reductions totaling 597 days). A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 31, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

On June 29, 2009, applicants timely submitted the present application for patent term adjustment¹. Applicants request review of the Patent Term Adjustment determination, in particular, (1) the 46 day period of reduction for applicant delay for the time period beginning on the day after the date that the response to the non-final Office action was filed, February 2, 2007,

¹ Office records show that the Issue Fee payment was received in the Office on June 29, 2009.

and ending on the date that the IDS was filed, March 19, 2007; (2) the failure of the Office to assess a reduction in connection with the filing of an Amendment under 37 CFR 1.312, and (3) applicant's entitlement to a period of patent term adjustment of at least 281 days for the failure of this Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a).

Applicants do not dispute the adjustment of 344 days under 1.702(a)(1). Applicants also do not dispute the reductions of 448 days (56 days; 94 days; 93 days, 11 days, 97 days; 36 days; 30 days, or 31 days) under 37 CFR §§ 1.704(b) and (c).

Regarding the reduction of 46 days attributed to applicants in connection with the IDS filed March 19, 2007, a review of the application file reveals the applicant was assessed a reduction of 46 days for the time period beginning on the day after the date that the response to the non-final Office action was filed, February 2, 2007, and ending on the date that the IDS was filed, March 19, 2007. Applicant, however, should have been assessed a reduction, pursuant to 37 CFR 1.704(c)(8), of 11 days² in connection with the filing of the IDS on February 12, 2007, and of 35 days associated with the filing of the IDS on March 19, 2007.

Applicants argue that the IDS filed March 19, 2008 "was accompanied by a statement that each item each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the IDS. Application for PTA at p.3. (Emphasis supplied). A review of the IDS filed March 19, 2007, reveals that the statement that accompanied the IDS stated that the communication was not received "by the office of the undersigned" more than thirty days prior to the filing of the IDS, and not that the communication was not received by "by any individual designated in § 1.56(c)" more than thirty days prior to the filing of the IDS. Supplemental Statement at p.2. Applicant failed to include a statement that complies with 37 CFR 1.704(d)³.

Accordingly, the PTA should have been reduced by 35 days, the number of days beginning on the day after the date the IDS filed February 12, 2007, and ending on the date that the subsequent IDS was filed, March 19, 2007.

Regarding the IDS filed August 27, 2008, a review of the application file reveals that the Office errantly neglected to assess a reduction of 90 days in accordance with 37 CFR 1.704(c)(8), in connection with the IDS, filed August 27, 2009. The reduction commenced May 30, 2008, the

² Applicant's do not dispute the adjustment of 11 days as noted *supra*.

³ A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable. 37 CFR 1.704(d) (Emphasis supplied).

day after the date that response to the non-final Office action was filed, and ended August 27, 2008, the date that the IDS was filed.

Further review of the record reveals that the Office also errantly neglected to assess a reduction in accordance with 37 CFR 1.704(c)(8) in connection with the IDS, filed January 29, 2009. The reduction commenced January 6, 2009, the day after the date that response to the non-final Office action was filed, and ended January 29, 2009, the date that the IDS was filed, or 24 days.

In view thereof, the patent term adjustment at the time of the mailing of the Notice of Allowance is zero (0) days (344 days of Office adjustment less 597 days of applicant delay (56 + 94 + 93 + 11 + 35 + 97 + 36 + 30 + 90 + 31 + 24), subject to any terminal disclaimer.

Regarding Applicant's calculation of a delay in connection with the filing of the Amendment under 37 CFR 1.312 incurred after the mailing of the Notice of Allowance, and Applicant's request for a patent term adjustment pursuant to 37 CFR 1.702(b) and 1.703(b), including any exclusion of the period of adjustment pursuant to 37 CFR 1.703(b)(4) in connection with the filing of the Notice of Appeal on October 27, 2005, 37 CFR 1.705(b) states that "[a]ny request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment." (Emphasis supplied). As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to adjustments that are not indicated in the Notice of Allowance and have not been reduced by this Office pursuant to § 1.704(b), the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does

not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee⁴.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight
Supervisor
Office of Petitions

⁴ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.